

Requirement for Restriction/Election for US Patent Application Number 10/518,823

Applicant notes the statutory grounds for election requirement in the November 18, 2008 Office Action as different from the grounds for restriction requirement in the August 5, 2008 Office Action.

- Applicant notes that in the August 5, 2008 Office action, the restriction requirement was solely based on 35 U.S.C. 121.
- Applicant notes that in the November 18, 2008 Office action, the restriction requirement is based on 35 U.S.C. 121, 35 U.S.C. 372 and 37 CFR 1.499.

Therefore, applicant hereby concedes the point that under 35 U.S.C. 372 and specifically 35 U.S.C. 372 (b)(2) and 37 CFR 1.499, the findings of the International Stage examiner on the question of unity are proper for reexamination at this stage (National Stage).

- Applicant notes that in the August 5, 2008 Office action, the restriction requirement distinguished 14 subcombinations (Claims 1, 10, 13-15, 22, 58, 97, 115, 121, 122, 145, 152, 178, 238, 268) as having separate utility, thus restrictable under MPEP §806.05 (d).
- Applicant notes that in the November 18, 2008 Office action, MPEP §806.05 (d) is no longer cited and the restriction requirement distinguishes 13 Groups (Claims **1&10**, 13-15, 22, 58, 97, 115, 121, 122, 145, 152, 178, 238, 268). The examiner argues that the inventions do not relate to a single inventive concept under PCT Rule 13.1 because under PCT rule 13.2, they lack the same corresponding special technical features; a lack of unity **a priori** is therefore claimed on the grounds there are no technical feature(s) that are common to all the claims.

However, the substantive grounds for traverse in the September 05, 2008 response to the August 05, 2008 office action are still valid; pursuant to 37 CFR 1.143, applicant still requests reconsideration and withdrawal or modification of the requirement. Applicant reiterates traversing the election requirement (37 CFR 1.499) on the basis that the examiner's arguments may still reflect some misunderstanding of the *technical feature(s) that are common to all the claims as outlined in the specification as interconnected central insights, namely:*

- i. the all encompassing description format for derivatives,
- ii. the identification and description format for BICs as most elementary component of derivatives, and
- iii. the formula enabling decomposition of any derivatives contract into the elementary components.

The Groups outlined by the examiner as Groups 1 to 13 share *technical feature(s) that are common to all the groups* because they derive their statutory inventiveness from their use of the interconnected central insights i-iii as **foundational building blocks**; none can be brought to separate inventive utility without such a technical relationship. The contribution which each of the claimed inventions, considered as a whole, makes over the prior art depends on the interconnected central insights i-iii. As such, all 13 groups are *related and require the particulars* of the central insights i-iii and therefore are directed to a *single unitary invention*.

Furthermore, restriction is not proper, there would be no serious burden if restriction were not required, since statutory inventiveness is directly related to *the absence of the*

central insights i-iii in the prior art for any separate classification, status, or field of search that may apply. Therefore, the applicable conditions set forth in PCT rule 13.1&13.2 or MPEP § 1850 do not apply.

However, in the event the restriction requirement becomes final, and since applicant's only option in the examiner's interpretation is to choose only a single Group as described, applicant elects with traverse the following claim as invention for consideration, corresponding to Group 11 outlined by the examiner with the typographic error BICs replaced by derivatives as follows:

14. (178) A method for mediating trading in BICs derivatives comprising:
 - a. establishing a BICs-basis;
 - b. establishing a network to facilitate interaction between stakeholders under the supervision of a trading system management authority;
 - c. causing said network to communicate with said stakeholders to enable a determination of trading prices for BICs trades ;
 - d. identifying relevant derivatives contracts;
 - e. decomposing said relevant derivatives contracts to create a portfolio of BICs; and,
 - f. finalizing a transaction in said portfolio of BICs.

Application further notes that the relationship is obvious in many different ways. For example, it is clear that before *trading of a BICs or derivatives contract can be mediated as outlined in claim 178 (also identified as Group 11), it must be formed as outlined in claims 1&10 (Group 1)*. As such, applicant requests that at least based on this obvious relationship, an election of claim 178 be grouped together with claims 1&10 (Group 1) in a single invention. If such a request were granted, applicant would further request adding their parallel systems (claims 4, 11, 198) and computer program (claim 7, 12, 218) claims as provided in the international application PCT/US2003/019179: